

REMARKS

Claims 1-6, 8-11, 13-22, 24-33, 37-41, and 43-46 are currently pending.

In the Office Action mailed November 10, 2003, the Examiner rejected claims 1-6, 8, 10-11, 13-16, 27-29, 31, 32, 37-41, 43, 44, and 46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,440,615 to Caccuro et al. ("Caccuro") in view of U.S. Patent No. 6,496,570 to Nimphius ("Nimphius"); rejected claims 20-22, 24-26, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Nimphius in view of Caccuro; rejected claims 17 and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,259,782 to Gallant in view of Caccuro; rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable Gallant and Caccuro in view of U.S. Patent NO. 5,583,920 to Wheeler, Jr. ("Wheeler"); and rejected claims 9, 30, and 45 under 35 U.S.C. § 103(a) as being unpatentable over Caccuro in view of Nimphius and further in view of U.S. Patent No 6,088,429 to Garcia

By this amendment, Applicant amends claims 17, 22, and 33 to more clearly define the present invention.

The Examiner rejected claims 1-6, 8, 10-11, 13-16, 27-29, 31, 32, 37-41, 43, 44, and 46 under 35 U.S.C. § 103(a) as being unpatentable over Caccuro in view of U.S. Nimphius. Applicant traverses this rejection for the reasons given below.

Claim 1 defines a method for reporting events in a wireless intelligent network. Claim 1 recites a combination including, *inter alia*, "identifying a group associated with a wireless subscriber when an event that indicates an error in routing a call to the wireless subscriber is detected." The Examiner incorrectly alleges that Caccuro at col. 5, line 26 discloses this element. Office Action, p. 2. A careful reading of the passage cited by

the Examiner reveals that Caccuro's voice message system never identifies a group associated with a wireless subscriber. Instead, Caccuro's system merely receives a call in response to a busy signal or ring no-answer (5:25-27). Then, Caccuro's system "selects a preferred language from a list of languages derived from matching the caller's country code and/or area code to corresponding fields in a selection table." (2:1-4; see also FIGs. 4-6 and related text). Rather than "identifying a group associated with a wireless subscriber ... wherein the group receives messages through the network in one of the plurality of formats," Caccuro simply plays a message based on the country codes, area codes, and/or trunk codes. To further illustrate this distinction by way of non-limiting example, since Caccuro merely uses country codes and area codes to select a language for voice mail playback instead of "identifying a group", Caccuro is not operative with, for example, TDD devices which may share the same area code with voice phones not equipped with TDD. For at least these reasons, Caccuro fails to teach or suggest a combination of steps including, for example, "identifying a group associated with a wireless subscriber when an event that indicates an error in routing a call to the wireless subscriber is detected." Claim 1 is thus allowable over Caccuro.

Although Nimphius discloses a mobile wireless network, Nimphius fails to cure the deficiencies of Caccuro since it is silent with respect to at least the "identifying" step recited in claim 1. As such, neither Caccuro nor Nimphius teaches or suggests the combination of claim 1, and it is allowable over Caccuro and Nimphius, either taken alone or in any reasonable combination. Therefore, the rejection under 35 U.S.C. § 103(a) of claim 1 and claims 2-6, 8, and 10, by reason of their dependency from allowable claim 1, should be withdrawn.

Independent claims 11, 27, and 37, although of different scope, include recitations similar to those of claim 1. Claims 13-16, 28-29, 31, 32, 37-41, 43, 44, and 46 depend variously from their corresponding independent claims 11, 27, and 37. For at least the reasons given with respect to claim 1, independent claims 11, 27, and 37 and dependent claims 13-16, 28-29, 31, 32, 37-41, 43, 44, and 46, at least by reason of their dependence from allowable independent claims, are allowable over Caccuro and Nimphius, either taken alone or in any reasonable combination. Therefore, the rejection of all of these claims under 35 U.S.C. § 103(a) should also be withdrawn.

As demonstrated above, a prima facie case of obviousness has not been made by the Examiner. To establish a prima facie case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. §2143.03 (8th ed. 2001).) Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. Moreover, each of these requirements must be found in the prior art, and not be based on Applicant's disclosure. (See M.P.E.P. § 2143 (8th ed. 2001).)

Concerning the motivation to combine, the Examiner appears to use hindsight reasoning when he suggests that it would have been obvious "to modify" Caccuro "with the wireless method taught by Nimphius." Office Action, p. 3. Even if such a modification were possible (which Applicant disputes), there is no clue in either

reference on why or how to make such a modification, or whether the modification would be successful. The Examiner's only apparent motivation to combine is that Caccuro fails to report events in a wireless network and Nimphius allegedly does. However, other than using impermissible hindsight, the Examiner has not provided any motivation to combine (nor any showing that a reasonable expectation of success would exist) from the references themselves as required by M.P.E.P. § 2143. Absent such support, the rejection of claims 1-6, 8, 10, 11, 13-16, 27-29, 31, 32, 37-41, 43, 44, and 46 should be withdrawn for these additional reasons.

The Examiner rejected claims 20-22, 24-26, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Nimphius in view of Caccuro. Applicant traverses this rejection for the reasons given below.

✓ Present claim 33 recites a combination including, *inter alia*, "providing a message to the first subscriber based on the directory number and a profile associated with the subscriber group corresponding to the first subscriber." Because neither Nimphius nor Caccuro discloses or suggests at least the use of a subscriber group, as noted above, claim 33 is thus allowable over Nimphius and Caccuro, either taken alone or in any reasonable combination. Therefore, the rejection under 35 U.S.C. § 103(a) of claim 33 should be withdrawn.

Claim 20 recites a combination of elements including, for example, "identifying a group associated with the first subscriber when an event that indicates an error associated with the call is detected." For at least the reasons given above, neither Nimphius nor Caccuro discloses or suggests at least these steps. Therefore, claim 20 is allowable over Nimphius and Caccuro, either taken alone or in any reasonable

combination. Therefore, the rejection of claim 20 under U.S.C. § 103(a) should be withdrawn.

Claim 21 depends from allowable claim 20. Independent claims 22 and 26 include recitations similar to those of claim 20. Claims 24-25 depend from claim 22. For at least the reasons given above with respect to claim 20, claims 21-22 and 24-26 are allowable over Nimphius and Caccuro, taken either alone or in any reasonable combination. Therefore, the rejection of claims 21-22 and 24-26 under 35 U.S.C. § 103(a) should be withdrawn.

Concerning the motivation to combine the cited references, the Examiner once again tries to use hindsight reasoning when he suggests that it would have been obvious "to modify" Nimphius "with the error events disclosed by Caccuro." Office Action, p. 5. Even if such a modification were possible (which Applicant disputes), there is no clue in either reference on how to make such a modification, or whether the modification would be successful. The Examiner's only apparent motivation to combine is these references is that Nimphius fails to disclose error events and Caccuro allegedly does. However, other than using impermissible hindsight, the Examiner has not demonstrated any motivation to combine (or reasonable expectation of success) from the references themselves as required by M.P.E.P. § 2143. Absent such support, the rejection of claims 20-22, 24-26, and 33 should be withdrawn for these additional reasons.

The Examiner rejected claims 17 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Gallant in view of Caccuro. Applicant traverses this rejection for the following reasons.

Present claim 17 recites a combination of elements including, *inter alia*, "establishing the call from the wireline subscriber to the message node based on the received directory number and a subscriber group associated with the wireless subscriber, when an event that indicates an error associated with the call is detected." Indeed, the Examiner acknowledges that Gallant fails to teach this element. Office Action, p. 6. Moreover, Caccuro fails to disclose or suggest at least the use of a subscriber group, as noted above. As such, neither Gallant nor Caccuro teaches or suggests the combination of claim 17, and it is thus allowable over Gallant and Caccuro, either taken alone or in any reasonable combination. Therefore, the rejection under 35 U.S.C. § 103(a) of claim 17 and claim 19, by reason of its dependency from allowable claim 17, should be withdrawn.

Concerning the motivation to combine, the Examiner's only apparent motivation to combine these references is that Gallant fails to teach establishing calls using a received directory number and Caccuro allegedly does. However, other than using impermissible hindsight, the Examiner has not shown that any motivation to combine (or reasonable expectation of success) is present from the references themselves as required by M.P.E.P. § 2143. Absent such support, the rejection of claim 17 and 19 should be withdrawn for these additional reasons.

The Examiner rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable Gallant and Caccuro in view of Wheeler. Applicant traverses this rejection for the following reasons.

Claim 18 depends from claim 17 and includes all the steps and recitations therein including, *inter alia*, "establishing the call from the wireline subscriber to the message

node based on the received directory number and a subscriber group associated with the wireless subscriber, when an event that indicates an error associated with the call is detected." As noted above, the Examiner acknowledges that Gallant fails to disclose this element. Office Action, p. 6. As also noted above, Caccuro fails to cure Gallant's deficiencies since Caccuro fails to disclose or suggest the use of a subscriber group. Lastly, although Wheeler discloses an intelligent peripheral in a video dial tone network, Wheeler fails to cure the deficiencies of Caccuro and Gallant. As such, neither Gallant, Caccuro, nor Wheeler teaches or suggests the combination of claim 18, and it is thus allowable over Gallant, Caccuro, Wheeler, either taken alone or in any reasonable combination. Therefore, the rejection under 35 U.S.C. § 103(a) of claim 18 should be withdrawn.

Concerning the motivation to combine Gallant, Caccuro, and Wheeler, the Examiner's only apparent motivation to combine these references is based on using Impermissible hindsight since the Examiner has not shown the presence of any motivation to combine (or reasonable expectation of success) from the references themselves as required by M.P.E.P. § 2143. Absent such support, the rejection of claim 18 should be withdrawn for these additional reasons.

The Examiner rejected claims 9, 30, and 45 under 35 U.S.C. § 103(a) as being unpatentable over Caccuro in view of Nimphius and further in view of Garcia. Applicant traverses this rejection for the reasons given below.

Claim 9 depends from claim 1 and includes all the steps and recitations therein including, *inter alia*, "identifying a group associated with a wireless subscriber when an event that indicates an error in routing a call to the wireless subscriber is detected." As

noted above with respect to claim 1, neither Caccuro nor Nimphius discloses or suggests this limitation. Moreover, although Garcia teaches an automated telephony system that includes features for the deaf, Garcia fails to cure the deficiencies of Caccuro, since Garcia is silent with respect to at least the step of "identifying" recited in claim 9. As such, neither Caccuro, Nimphius, nor Garcia teaches or suggests the combination of steps recited in claim 9, and it is thus allowable over these cited references, either taken alone or in any reasonable combination. Therefore, the rejection under 35 U.S.C. § 103(a) of claim 9 should be withdrawn.

Claims 30 and 45, although of different scope, include recitations that are similar to those of claim 9. For at least the reason given with respect to claim 9, the rejection under 35 U.S.C. § 103(a) of claims 30 and 45 should be withdrawn.

Concerning the motivation to combine Caccuro, Nimphius, and Garcia, the Examiner's only apparent motivation to combine these references is based on using impermissible hindsight (see Office Action p. 9) since the Examiner has not demonstrated any motivation to combine (or expectation of success) from the references themselves as required by M.P.E.P. § 2143. Absent such support, the rejection of claims 9, 30, and 45 should be withdrawn for these additional reasons.


In view of the foregoing remarks, Applicant submits that this claimed invention, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 07-2347.

Respectfully submitted,

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